

Serial No. 10/621,643
Docket No. PRG 0001 PA
Response date October 7, 2005
Reply to Office Action of June 7, 2005

REMARKS

Status of claims

Applicants thank the Examiner for the consideration given to the present application. Claims 1, 2, 4, and 5 have been canceled without prejudice. Claims 3, 6, 10, 15, 16, and 18 have been amended to correct either dependency or grammatical errors, support of which may be found in the specification and figures. Such amendment had nothing to do with patentability of the claims over the prior art. Claim 33 has been added to more clearly claim an embodiment of the present invention, support of which may be found in the specification and figures. No new matter has been added. Claims 3, 6-16, 18-33 are pending in the present application.

Rejections under 35 U.S.C. §101

The Examiner has rejected claims 1-32 under 35 U.S.C. §101 because he alleged the disclosed invention is inoperative and therefore lacks utility. Applicant respectfully traverses this rejection and asserts that a rejection under §101 based upon inoperability is improper in the present application. First, "Situations where an invention is found to be 'inoperative' and therefore lacking in utility are rare." MPEP §2107.01, II. Second, the Federal Circuit has stated, "[t]o violate [35 U.S.C.] 101 the claimed device must be totally incapable of achieving a useful result." *Booktree Corp. V. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992) (emphasis added)). See also *E.I. du Pont De Nemours and Co.*, 620 F.2d 1247, 1260 n.17, 205 USPQ 1, 10 n.17 (8th Cir. 1980) ("A small degree of utility is sufficient.....An invention does not lack utility merely because the particular embodiment disclosed in the patent lacks perfection or performs crudely.....Nor is it essential that the invention accomplish all its intended functions...or operate under all conditions...").

The present invention is not totally incapable of achieving a useful result as required to uphold a rejection under §101. As stated in the specification, the present invention helps a bowler become more accurate by showing the bowler where to stand and what target to look at to achieve the correct break point on the lanes on a given day. (p. 19, lines 2-7). The specification also states that the present invention assists a bowler by showing him "where to release the ball and what to target in their shot to achieve a desired breakpoint." (p. 2, lines 27-30).

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Applicant respectfully submits that the Examiner has not met his initial burden of challenging the Applicant's presumptively correct assertion of utility as set forth above. The Federal Circuit has stated, "Only after the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince such a person of the invention's asserted utility." *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). The Examiner offered as evidence in support of the conclusion of inoperability that many factors such as weight, and cover stock material of the ball, type of lane surface, oiling conditions, and style of bowler "would control the exact placement of the bowling ball," and since Applicant's invention does not take these factors into account, the Examiner concluded, "it is clear that the desired results cannot be repeatably obtained." In an attempt to further support this position the Examiner stated that the prior art also teaches that a quantitative system for bowling will not work consistently and then noted to the reference "*Strike and Spare Systems-Targeting Systems*".

Applicant submits that this evidence proffered by the Examiner is insufficient to cause one of ordinary skill in the art to doubt the asserted utility. A target aid and/or guide is just that, an aid to assist one in targeting or aiming more accurately. It does not have to be perfect as incorrectly required by the Examiner ("exact placement"). In sharp contrast to the Examiner's conclusion that it is clear that the desired results cannot be repeatably obtained, Applicant submits that the knowledge in the art teaches that bowling targeting aids, although different than the present invention, are operable and have utility as exemplified by the cited references (e.g., *Brunswick Arvilane, Complete Bowling Index "Targeting Aids: The dots and arrows"*). These bowling targeting aids would also be affected by the factors set forth by the Examiner, but must have some minimal utility or they would not be found in countless bowling alleys and available in the market.

Moreover, the reference, "*Strike and Spare Systems - Targeting Systems*", submitted by the Examiner as evidence that bowling targeting systems are not operable, actually teaches the opposite. This reference states that these systems are "not written in stone: sometimes they can let you down - for example, if there is more oil in the middle of the lane....But, by combining these systems you can be really creative in choosing your shots....If your opponent isn't able to

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do this you have a competitive advantage." (p. 2). This reference further states, "for more complex spares these systems can increase your accuracy." (p. 1).

Applicant respectfully submits that this evidence, alone, would prevent one of ordinary skill in the art to doubt the asserted utility (that the present invention is capable of assisting a bowler in where to release the ball and what target to look at to achieve a correct break point on the lanes). In sum, similar to the conventional bowling targeting aids, the present invention may be affected by the factors set forth by the Examiner, however this does not translate into the present invention being totally incapable of achieving a useful result. Thus, Applicant respectfully submits that the evidence proffered by the Examiner is insufficient to rebut the presumption of utility of the present invention.

In addition, the Examiner rejected claims 1-32 under 35 U.S.C. §101 for being directed to non-statutory subject matter. To support this rejection, the Examiner stated that claims 1-17 pertain to indicia or a kit of indicia which he alleged is a mere arrangement of printed matter, not within the statutory classes, and that claims 17-32 are drawn to abstract ideas rather than definite physical steps that produce consistent predictable results. Applicant respectfully traverses these rejections under §101 as well.

Regarding the Examiner's reasoning for his rejection of claims 1-17, independent claims 1 and 17 have been canceled without prejudice, leaving independent claims 10, 15, and 16. Applicant asserts that these claims recite more than a mere arrangement of printed matter. The Federal Circuit has held that printed matter, if functionally related to an article of manufacture, can be given patentable weight. *In re Miller*, 46 USPQ 46, 48-49 (CCPA 1969). Moreover, the Federal Circuit in *In re Miller* held, "Claims 10-12 call for the indicia being 'on' and the legend being 'attached to' the receptacle. Claim 13 specified that the indicia and the legend are both 'on' the 'cup-shaped receptacle.' This specified the required functional relationship to carry out appellant's invention." *Id.* at 48. Applicant's claim 10 recites, *inter alia*, a substrate having a table recorded onto the substrate, wherein the table comprises a plurality of release points, break points, and target points such that a select on of the target points correspond to a select one of the release points and a select one of the break points.

Similar to *In re Miller*, Applicant's claim 10 recites the table recorded onto a substrate (i.e., an article of manufacture), claim 15 recites the table disposed on a fixed medium (which

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may comprise a substrate, i.e., an article of manufacture), and claim 16 recites a kit comprising a target guide and a visual guide stored on a fixed medium that includes video examples. Thus, independent claims 10, 15, and 16 specify the required functional relationship to overcome a rejection under §101.

Regarding the Examiner's reasoning for his rejection of claims 17-32, independent claim 17 has been canceled without prejudice, leaving independent claims 19, 20, and 33. Applicant respectfully asserts that these claims recite a process that includes a transformation and "given results". The requirement for a "transformation" is one that the claim recite a "physical application, i.e., 'a useful, concrete, and tangible result.'" *State St. Bank & Trust Co.*, 149 F.3d 1368, 1371, 47 USPQ2d 1596, 1600-01 (Fed. Cir. 1998). Claim 19 recites a method of improving the accuracy of aim in a game of bowling, and claim 20 recites a method of teaching a bowler how to align a bowling shot, and claim 33 recites a method of creating a target guide for assisting bowlers in aligning a shot.

As stated in the specification, the present invention helps a bowler become more accurate by showing the bowler where to stand and what target to look at to achieve the correct break point on the lanes on a given day. (p. 19, lines 2-7). A target aid and/or guide is just that, an aid to assist one in targeting or aiming more accurately. It does not have to be perfect as incorrectly required by the Examiner ("exact placement"). Claims 19 and 20 recite a process that provides a bowler steps to increase his accuracy by assisting him on what to target based upon his release point and desired break point, and claim 33 recites a process to create such a target guide. Applicant submits that bowling targeting aids and methods, can provide useful, concrete, and tangible results as exemplified by *"Strike and Spare Systems - Targeting Systems"*, which teaches that these systems and methods "can increase your accuracy." (p. 1). Similarly, Applicant's processes recited in claims 19, 20, and 33 provide useful, concrete, and tangible result, i.e., increased accuracy.

Accordingly, Applicant respectfully requests that the rejection of independent claims 10, 15, 16, 19, 20, and 33 under 35 U.S.C. §101 be withdrawn. As claims 3, 6-9, 11-14, 18, and 21-32 depend from claims 10, 15, 16, 19, 20, or 33, the rejection of these claims under 35 U.S.C. §101 should be withdrawn as well.

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Rejection under 35 U.S.C. §102

Claims 1-32 are rejected under 35 USC 102(b) as being anticipated by Brunswick Anvilane. or, in the alternative, under 35 USC 103(a) as being unpatentable over *Complete Bowling Index "Targeting Aids: The dots and arrows"* in view of *AMF and PRO TIPS: Cheryl Daniels*, and further in view of *BowlingFans.com (Kegler's)* and *Speed Control*. Applicant respectfully traverses this rejection.

To anticipate a claim under §102, each and every element of the claim must be found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In addition, "the identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The Brunswick Anvilane reference does not teach each and every element of applicants claims.

Claims 10 and 15 recite, *inter alia*, a table recorded onto a substrate or a fixed medium, wherein the table comprises a plurality of target points that define predetermined position on the bowling lane that corresponds to a select one of the release points and break points. Claim 16 recites a kit for teaching a bowling technique comprising, *inter alia*, a visual guide stored on a fixed medium that includes video examples.

Brunswick Anvilane is completely void of any teaching of a table recorded on a substrate or fixed medium or of a visual guide stored on a fixed medium. Moreover, Brunswick Anvilane does not teach or suggest a plurality of target points, wherein each select one of the target points defines a predetermined position on the bowling lane that corresponds to a select one of the release points and a select one of the break points. Brunswick Anvilane is silent as to any teaching on any such relationship between a select target point corresponding to a combination of a release point and break point, let alone a table including these relationships. Finally, Brunswick Anvilane does not teach or suggest a kit that includes visual guide stored on a fixed medium that includes video examples. In sum, the Brunswick Anvilane reference is lacking at least one, if not several, of the elements of independent claims 10, 15, and 16.

Claims 19, and 20 recite a method of improving accuracy of aim and aligning a shot in bowling, respectively, comprising, *inter alia*, the steps of identifying a target line for a plurality of combinations of release points and break points, determining a target position defined as a

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point along the target line, storing on a fixed media the select one of the plurality of release points, the select one of the plurality of break points, and the target position, and identifying a first target position on the fixed media corresponding to the first release point and the first break point. Claim 33 recites a method of creating a target guide for assisting bowlers in aligning a shot comprising, *inter alia*, identifying a target line, predetermining a respective target point for each combination of a select one of the plurality of release points and a select one of the plurality of break points, and storing on a fixed media the combinations of a select one of the plurality of release points and break points and the respective target points for the combinations. The Brunswick Anvilane reference has no teaching or suggestion of any of the following steps: identifying a target line; storing on a fixed media; identifying a first target position on the fixed media corresponding to the first release point and the first break point; or predetermining a respective target point for each combination of release and break points. Therefore, Brunswick Anvilane is also lacking at least one, if not several, of the elements in Applicant's independent claims 19, 20, and 33.

Thus, the Brunswick Anvilane reference does not teach, expressly or inherently, each and every element of independent claims 10, 15, 16, 19, 20, and 33. Accordingly, Applicant respectfully requests the rejection of independent claims 10, 15, 16, 19, 20, and 33 under 35 U.S.C. §102(b) be withdrawn. As claims 3, 6-9, 11-14, 18, and 21-32 depend from claims 10, 15, 16, 19, 20, or 33, the rejection of these claims under 35 U.S.C. §102(b) should be withdrawn as well.

Rejections under 35 U.S.C. §103

Claims 1-32 are rejected under 35 USC 103(a) as being unpatentable over *Complete Bowling Index "Targeting Aids: The dots and arrows"* (hereinafter "CB") in view of *AMF* and *PRO TIPS: Cheryl Daniels*, and further in view of *BowlingFans.com* (Kegler's) and *Speed Control*. Applicant respectfully traverses this rejection and submits that the Examiner has not met his burden of establishing a prima facie case of obviousness under §103. MPEP §2145.

In order to establish a prima facie case of obviousness under §103, the Examiner has the burden of showing, by reasoning or evidence, that: 1) there is some suggestion or motivation, either in the references themselves or in the knowledge available in the art, to modify that

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reference's teachings; 2) there is a reasonable expectation on the part of one of ordinary skill in the art that the modification or combination has a reasonable expectation of success; and 3) the prior art references (or references when combined) teach or suggest all the claim limitations. MPEP §2145.

Claims 10 and 15 recite, *inter alia*, a table recorded onto a substrate or a fixed medium, wherein the table comprises a plurality of target points that define predetermined position on the bowling lane that corresponds to a select one of the release points and break points. Claim 16 recites a kit for teaching a bowling technique comprising, *inter alia*, a select one of the target points defines a predetermined position on the bowling lane that corresponds to a select one of the release points and a select one of the break points and a visual guide stored on a fixed medium that includes video examples. Claims 19, and 20 recite a method of improving accuracy of aim and aligning a shot in bowling, respectively, comprising, *inter alia*, the steps of storing on a fixed media the select one of the plurality of release points, the select one of the plurality of break points, and the target position, and identifying a first target position on the fixed media corresponding to the first release point and the first break point. Claim 33 recites a method of creating a target guide for assisting bowlers in aligning a shot comprising, *inter alia*, predetermining a respective target point for each combination of a select one of the plurality of release points and a select one of the plurality of break points, and storing on a fixed media the combinations of a select one of the plurality of release points and break points and the respective target points for the combinations.

The *CB* and *AMF* references are completely void of any teaching or suggestion, singularly or in combination, of break points. And, although *BowlingFans.com*, *Speed Control*, and *PRO TIPS* discuss break points, none of the references, singularly or in combination, teach or suggest having a select release point and break point combination tied to a select target point to assist a bowler in where to look at (target) when trying to hit a certain break point. All three only mention or discuss the break point as a spot down the bowling lane where the bowler should look to see where their ball is actually breaking due to lane conditions, their throwing style, and/or other factors. However, none of the cited references teach or suggest, singularly or in combination, a target point tied to a select release point and break point as required by all the claims. Such a relationship is complex and unobvious. Moreover, these references are also void

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of any teaching or suggestion of placing such a relationship in a table recorded on either a substrate or fixed medium. Finally, the cited references do not teach or suggest, singularly or in combination, a visual guide that includes video examples as required in claim 16.

Accordingly, since *Brunswick Anvilane*, *CB*, *AMF*, *PRO TIPS*, *BowlingFans.com*, and/or *Speed Control*, singularly or in combination, do not teach every limitation of Applicant's independent claims 10, 15, 16, 19, 20, and 30, Applicant respectfully requests the rejection of these claims under 35 U.S.C. §103 be withdrawn. As claims 3, 6-9, 11-14, 18, and 21-32 depend from claims 10, 15, 16, 19, 20, or 30, Applicant also requests the rejection of these claims be withdrawn as well.

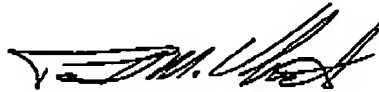
CONCLUSION

Applicants respectfully submit that the present application is in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,

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